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501.20699VC2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): R. HORI, et al.
Serial No.: 07/869,851
Filed: April 16, 1992
For: SEMICONDUCTOR INTEGRATED CIRCUIT
Group: 2306
Examiner: S. Baker

PETITION FOR COMPLETE OFFICE ACTION

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

June 7, 1994

Sir:

This Petition is being filed in response to the May 13, 1994 final Office Action in which the Examiner merely referred to paragraphs of the previous January 13, 1993 Office Action as the reason for finally rejecting the claims based upon prior art.

FACTS:

On January 13, 1993 the Examiner issued an Office Action rejecting claims 13, 15, 17-20, 22, 24-33, 43-51, 61, 62, 65, 66 and 69 under 35 USC §112, second paragraph; claims 7, 9-11, 13, 15, 17, 18 and 20-70 under 35 USC §103 as being unpatentable over Alaspa and claims 69 and 70 under 35 USC §103 as being unpatentable over Alaspa and Takanishi. In response to the January 13, 1993 Office Action Applicants filed an Amendment on July 13, 1993 in which the claims were amended to

overcome the 35 USC §112, second paragraph rejection and to more clearly recite the features of the present invention not taught or suggested by the references of record. Essentially the claims were amended to recite that:

"The magnitude of said internal supply voltage changing at said second rate is not smaller but larger than that of said internal supply voltage changing at said second rate."

and were amended to recite that:

"The magnitude of said internal supply voltage becomes larger without decreasing in proportion to an enlargement of said magnitude of said internal supply voltage."

These features of the present invention were specifically argued in the "REMARKS" of the July 13, 1993 Amendment, for example, as can be found on page 14, line 15 through page 15, line 18 (advantages of present invention described); page 16, lines 17-24 and page 17, lines 21-27 of the July 13, 1993 Amendment. In response to the July 13, 1993 Amendment the Examiner issued the May 13, 1994 final Office Action.

In the May 13, 1994 Office Action the Examiner rejected claims 7, 9-11, 13, 15, 17-23 and 25-70 under 35 USC §112, second paragraph, rejected claims 7, 9-11, 13, 15, 17, 18 and 20-70 under 35 USC §103 as being unpatentable over Alaspa and rejected claims 69 and 70 under 35 USC §103 as being unpatentable over Alaspa as applied to claims 20 and 23 and further in view of Takanishi. In support of the rejection of claims 7, 9-11, 13, 15, 17, 18 and 20-70 under 35 USC §103 as being unpatentable over Alaspa the Examiner merely stated that:

"reference is hereby made to paragraph 4 of the Office Action mailed on 1/13/93 as paper no. 18 for an exposition of this rejection."

With respect to the rejection of claims 69 and 70 under 35 USC §103 as being unpatentable over Alaspa as applied to claims 20 and 23 and further in view of Takanishi the Examiner merely stated that:

"Reference is hereby made to paragraph 5 of the Office Action mailed on 1/13/93 as paper No. 18 for an exposition of this rejection."

POINTS TO BE REVIEWED:

MPEP §707.07(f) specifically sets forth that:

"Where the Applicant traverses any rejection, the Examiner should, if he or she repeats the rejection, take note of Applicants' argument and answer the substance of it."

MPEP §707.07(f) further states that:

"If it is the Examiner's considered opinion that the asserted advantages are without significance in determining patentability of the rejected claims, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the Applicant will know that the asserted advantages have actually been considered by the Examiner and, if appeal is taken the Board of Patent Appeals and interferences will also be advised."

MPEP §707.07(f) states that the importance of answering such arguments is illustrated by In re: Herrmann, et al., 1959 CD 159; 739 OG 549 where the Applicant argued that the subject matter claimed produced new and useful results. The court in Herrmann noted that since Applicants statement of advantages

was not questioned by the Examiner or the Board of Appeals it was constrained to accept the statement as face value and therefore found certain claims to be allowable.

In the present situation the Examiner did not address nor question any of the stated advantages of the present invention and the language added to the claims in support thereof in the May 13, 1994 Office Action. Therefore, Applicants have not been apprised of the Examiner's position with respect to these stated advantages and the language added to the claims. Therefore, Applicants respectfully request that a complete Office Action be issued specifically setting forth the Examiner's position with respect to the stated advantages of the present invention and the language in support thereof added to the claims so as to apprise Applicants and the Board of Patent Appeals and Interferences the specific reasons why the Examiner maintains the rejections.

ACTION REQUESTED:

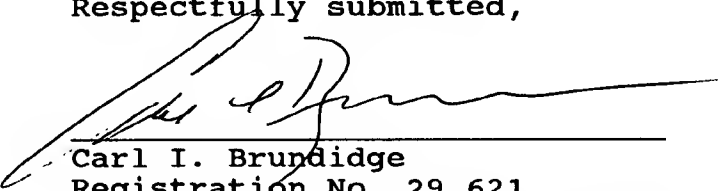
It is respectfully requested that the Commissioner exercise supervisory authority over the Examiner to issue a complete Office Action addressing the specific advantages and the language in support thereof added to the claims and reset the period for response to begin from the date of the complete Office Action.

To the extent necessary, applicants petition for an extension of time under 37 C.F.R. section 1.136. Please charge any shortage in the fees due in connection with the filing of

this paper, including extension of time fees, to Deposit
Account No. 01-2135 (Case No. 501.20699VC2) and please credit
any excess fees to such Deposit Account.

Respectfully submitted,

(202) 828-0300
CIB/hpg



Carl I. Brundidge
Registration No. 29,621
ANTONELLI, TERRY, STOUT & KRAUS